

REMARKS

Applicant thanks the Examiner for the consideration given the present application.

Claims 3-27 are now present in this application. Claims 3, 10, 16, 17, 23, 26 and 27 are independent. Claim 17 is amended. Claims 28-33 are canceled. No new matter is involved. Support for the amendment of claim 17 is found throughout Applicant's original disclosure including, for example, original claim 3. Reconsideration of this application, as amended, is respectfully requested.

Examiner Telephone Interview

Applicant acknowledges with appreciation the courtesies extended by Examiner Karmis to the below-named representative during a telephone interview held on November 3, 2005. During that interview, Examiner Karmis indicated that claims 3-16 appeared to be allowable over the applied art. Agreement, however, was not reached regarding the patentability of claims 17-27 over the applied art.

Claim Rejections under 35 U.S.C. §103

Claims 3, 4, 7, 10-14, 16-22, 26 and 27 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,446,049 to Janning in view

of U.S. Patent 6,536,661 to Takami et al. (hereinafter, "Takami"). Applicant respectfully traverses this rejection and requests reconsideration thereof.

In rejecting claims under 35 U.S.C. §103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. See, In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. E-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not

make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

A showing of a suggestion, teaching, or motivation to combine the prior art references is an “essential evidentiary component of an obviousness holding.” C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not “evidence.” See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

Independent claims 3, 10 and 16 positively recite, among other features, a “radio signal receiving block for . . . determining whether the received signal corresponds to a general information or a balance storing information.”

Contrary to what is asserted in the office Action, Janning does not disclose this positively recited feature. Applicant has reviewed Janning and has not found where Janning discloses or suggests a radio signal receiving block for

determining whether the received signal corresponds to a general information or a balance storing information.

Janning discloses that a “. . . product vending system determines whether the received signal includes billing information for a consumer to be charged for the product.” (col. 27, lines 8-22). Janning goes into more detail starting in col. 27, line 13, by stating that the product vending system determines whether the received radio signal includes a credit card number, a debit card account number, or some other account number to facilitate payment for the product to be vended. Janning also “determines the validity of billing the account, for example, by determining whether the radio signal also includes information related to the expiration date of the account (e.g. an expiration date of a credit card.” (col. 27, lines 18-22).

Janning’s disclosure of “billing information” is in the context of identification of a valid credit card account or debit card account that can be billed and contains no disclosure or suggestion of “balance storing information” or of distinguishing between general information and balance storing information associated with a credit or debit card account.

The specific portions of Janning relied on in the rejection, i.e., portions of cols. 28 and 29 of Janning, disclose “stored account numbers” and “account validity information, such as credit card expiration date,” but do not disclose or suggest account balance information or storing account balance information.

Janning appears to be focused on "billing information" and uses that term valid account and does not disclose or suggest using account balance information in any way whatsoever.

Accordingly, Janning fails to disclose the claimed invention of disclosing or suggesting a radio signal receiving block for determining whether the received signal corresponds to a general information or a balance storing information.

So, even if it were proper to modify Janning in view of Takami, as suggested, the resulting modified version of Janning would neither meet nor render obvious, the claimed invention.

Furthermore, Takami neither discloses nor suggests any device for "determining whether the received signal corresponds to a general information or a balance storing information." In other words, neither applied reference discloses or suggests this positively recited feature. So, no matter how these two references are combined, they cannot possibly render obvious the claimed invention.

The Office Action also admits that Janning fails to teach storing the balance string extracted from the radio signal after comparing extracted serial numbers. In an attempt to remedy this deficiency, the Office Action turns to Takami.

The Office Action states that Takami's system approves electronic money transactions wherein a radio transmitter is used and ID's from the radio

transmitter are compared to approve electronic money information. The Office Action also notes that, after the ID comparison, the IC card stores the electronic money information into the electronic money information memory, referencing the fourth embodiment disclosed at col. 12, in lines 32-42.

The Office Action concludes that it would have been obvious to modify Janning to include storing the electronic money information as taught by Takami because Janning already teaches memory for storing billing information (col. 11, lines 30-44).

Applicant respectfully disagrees.

Janning does not disclose a need to store the billing information it extracts from the users card after a verification decision is made, nor does Janning disclose storing such information after a verification decision is made. In this regard, the Office Action asserts that storing the balance information after the number (ID) comparison is approved would update the billing information for the next transaction, which has to reference the memory. However, Janning has no need to use that information because Janning does not disclose an interest in such information as it is not needed for its disclosed verification purposes.

Accordingly, the Office Action fails to make out a *prima facie* case that one of ordinary skill in the art would be motivated to provide Janning with a feature that it does not need to perform its disclosed purpose.

With respect to claim 7, Takami does not disclose the recited "non-contact

block for storing a balance storing amount into the memory block using a card storage unit and reading a balance storing amount of the memory device when paying the money” feature, as alleged. The alleged basis in the outstanding Office Action has changed from what was alleged in the previous Office Action, The outstanding Office Action states that this feature is disclosed in col. 9, line 59 through col. 10, line 32. Applicant respectfully disagrees. Applicant respectfully points out that there is no explicit disclosure of “balance information” from col. 9, line 59 to col. 10, line 32, and the Office Action fails to explain where balance information is inherently (i.e., necessarily – not just probably or possibly) disclosed in this portion of Takami.

Similar comments apply to the rejections of claims 11-13, which also rely on col. 9, line 59 through col. 10, line 41.

Further, with respect to claim 14, which recites a control means for decrypting a balance storing information, allegedly shown somewhere in the 67 or so lines referenced in the rejection in columns 11 and 12, Applicant respectfully submits that there is no such disclosure in Takami, who does not disclose anything to do with balance information in the referenced text, let alone storing the balance storing information, as recited. This argument, which was presented in the Replies filed on August 18, 2004 and December 6, 2004, has not been addressed in the outstanding Office Action, thereby violating the express requirements of MPEP §707.07(f). Furthermore, while there is signal

encryption disclosed in Janning, relative to describing Fig. 13 (col. 27, lines 47-51), there is no disclosure of decryption of balance storing information.

Further, with respect to claim 18, Applicants cannot find any “balance storing information” disclosed in Janning, especially in col. 28, lines 19-52.

Further, with respect to claims 19 and 20, as noted above, Applicants have not found in Janning any disclosure of decrypting for certification at all.

Further, with respect to claim 21, Applicants have reviewed Janning *in toto*, as well as col. 27, lines 32-51, and cannot find any disclosure of balance storing information or determining whether one is a proper subscriber based on this non-existent information.

Further, with respect to claim 22, as pointed out above, Janning has no need to store balance information and the office Action has not provided objective factual evidence of proper motivation to modify Janning to include such a feature.

Further, with respect to claim 27, reference is made to the aforementioned traversals of claims 11-14 and 18-22.

With respect to claim 26, nowhere can Applicant find in Takami or in Dahm, a disclosure of “personal information update information,” or “determining whether a received radio signal corresponds to personal information update information,” or of extracting a certain variable if the signal corresponds to such information, or any of the other steps recited in claim 26.

In fact, the rejection does not even address the positively recited features of claim 26. This clearly violates Applicant's fundamental procedural and substantive due process rights and fundamentally flaws the rejection of claim 26.

Moreover, as pointed out above, the Office Action also fails to make out a *prima facie* case of obviousness of the claimed invention by failing to provide any motivation to combine these two applied references.

For the aforementioned reasons, Applicant respectfully submits that claims 3, 4, 7, 10-14, 16-22, 26 and 27 are not rendered unpatentable over Janning in view of Takami, and these rejections are improper and should be withdrawn.

Claims 5, 6, 8, 9, 15 and 23-25 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Janning in view of Takami and further in view of U.S. Patent 6,105,006 to Davis et al. (hereinafter, "Davis"). This rejection is respectfully traversed.

Initially, Applicant notes that, with respect to claims 5, 6 and 8, that depend from claim 3, the Janning and Takami references were applied in the rejection of claim 3, from which claims 5, 6 and 8 depend, and that Janning and Takami do not disclose or suggest many of the recited features in claims 5, 6 and 8 for the same reasons that claim 3 is not rendered obvious by Takami and Dahm.

Moreover, Davis '006 only discloses "balance" in terms of a single sentence

that is found in two separate locations in Davis, i.e., in col. 18, lines 34-38, and in col. 19, lines 36-40, which states that Davis' transaction processing system authenticates smart card 920, the requesting party's financial status (e.g., account balance, credit availability, etc.) and either completes or denies the transaction.

So, even if these three references were properly combined (which they are not for reasons stated below), they would not result in, or render obvious, the claimed invention recited in claims 5, 6 and 8.

As noted above, in rejecting claims under 35 U.S.C. §103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. See, In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985),

cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

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Davis teaches using a “distinctive audio alert pattern” to signal that “the financial transaction has been completed without error.” Davis does not teach generating “a call sound or an error sound during the balance storing operation” as recited.

Generating an audio alert pattern after an entire transaction has been completed without error is just the opposite of generating a call tone or an error sound during a balance storing operation.

The Office Action never explains why it would be obvious to modify the improper Janning-Takami reference combination to provide a tone signal generator to generate a call sound or an error signal during the balance storing information. In fact, the rejection never addresses this issue.

Accordingly, the Examiner has not made out a *prima facie* case of proper motivation to combine the references or a *prima facie* case of obviousness of the invention recited in claims 5, 6 and 8, which is neither met nor made obvious by the resulting reference combination of Takami, Dahm and Davis.

With respect to claim 9, which recites a control means for decrypting an output signal of the radio apparatus, extracting certification information if there is a service stop signal, disables the memory block when the extracted certification information is the same as previously stored certification information and stopping service of the card. Applicant respectfully submits that there is no such disclosure in Janning or Takami or Davis ‘006. Specifically, and

contrary to the Office Action's assertions, Janning contains no disclosure about decryption, only briefly mentioning encryption in col. 27, lines 47-51.

With respect to claim 15, Applicant notes that claim 15 is not disclosed, suggested or rendered obvious by the applied references for the same reasons that claim 10, from which these claims depend, is not disclosed, suggested or rendered obvious by Janning or Takami or Davis.

Moreover, for reasons stated above, Applicant respectfully submits that the Examiner has not made out a *prima facie* case of proper motivation to combine the references or a *prima facie* case of obviousness of the claimed invention.

With respect to claims 23-25, neither Janning nor Takami nor Davis disclose the claimed invention. Davis comes closest by disclosing that its transaction processing system authenticates the smart card 920, the requesting party's financial status (such as its account balance, etc.) and either completes or denies the transaction. Neither Takami nor Janning disclose this feature. Moreover, neither Janning nor Takami nor Davis discloses determining whether there is no balance storing information and releasing a card service stop if extracted certification information is the same as previously stored certification information, as recited in claims 23-25.

Accordingly, even if these references were somehow combined, they would not result in, or render obvious, the claimed invention.

The Office Action asserts that Davis teaches stopping of the financial transaction with improper signals, referencing col. 11, line 59 through col. 12, line 5 and col. 23, lines 27-38. Applicant respectfully submits that col. 11, line 59 to col. 12, line 5 is Davis is irrelevant to the claimed invention and deals only with code word identification. Moreover, col. 23, lines 27-38 does not disclose, or suggest, "determining whether a card service stop or release information is received if there is no balance storing information," as recited in claims 23-25. Nor does referring to the aforementioned portion of Davis and alleging that Davis teaches completion of financial information, which does not even mention card balance information or card service stop information or card service stop release information, let alone determining if such information is received if there is no balance setting information, provide objective factual evidence of the existence of these claimed features in Davis.

Furthermore, there is absolutely no statement of why one of ordinary skill in the art would be motivated to modify Janning/Takami, which do not disclose the recited features of claims 23-25, in view of Davis, which also does not disclose those claimed features. The only motivation statement in this rejection concerns an audible alert pattern, which has nothing to do with the features recited in claims 23-25.

In other words, not only do the two applied references not disclose a number of the positively recited features of claims 23-25, so that even if they

were properly combined, they would not meet or render obvious the claimed invention, but, additionally, no objective factual evidence of proper motivation to modify Takami/Dahm in view of Davis is found in the rejection.

Accordingly, the Office Action fails to make out a *prima facie* case of obviousness of the claimed invention.

Thus, the Examiner does not make out a *prima facie* case of obviousness of the claimed invention recited in claims 23-25.

Accordingly, the Examiner does not make out a *prima facie* case of obviousness of the claimed invention recited in claims 27-33.

For at least the foregoing reasons, it is respectfully submitted that all pending claims are allowable over the applied art, regarding the rejection of claims 5, 6, 8, 9, 15, 23-25, 26 and 27.

Accordingly, all claims, i.e., claims 3-27, should be allowed.

CONCLUSION

The stated grounds of rejection have been properly traversed, accommodated, or rendered moot. It is believed that a full and complete response has been made to the outstanding Office Action, and that the present application is in condition for allowance.

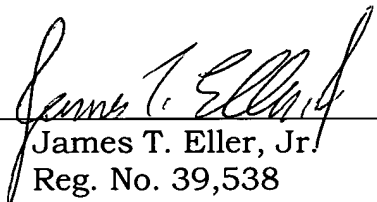
However, if there are any outstanding issues, the Examiner is invited to telephone Robert J. Webster, Reg. No. 46,472, at 703-205-8000, in an effort to

expedite prosecution.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17, particularly extension of time fees.

Respectfully submitted,

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